

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HIROTOSHI FUJISAWA

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Appeal No. 95-3852  
Application 07/855,945<sup>1</sup>

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HEARD: February 4, 1998

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Before THOMAS, JOHN D. SMITH and McQUADE, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:

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<sup>1</sup> Application for patent filed March 23, 1992.

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The ornamental design for a SHUTTER FOR AN OPTICAL DISC CARTRIDGE as shown and described.

The examiner has relied upon the following reference:

Shiba et al. (Shiba)	5,195,084	Mar. 16, 1993
		(filed May 14, 1991)

The design claim stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Shiba alone.<sup>2</sup> We refer to the briefs and the answers for the respective positions of the appellant and the examiner.

#### OPINION

Having considered the obviousness issue raised in this appeal in light of the teachings of the applied prior art and in light of the examiner's remarks and appellant's arguments, it is our conclusion that the examiner's rejection of the present design claim must be reversed.

"In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration." See In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). Where the inquiry

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<sup>2</sup> The supplemental examiner's answer indicates the examiner has withdrawn a provisional obviousness-type double patenting rejection set forth in the initial answer with respect to co-pending application Serial No. 07/855,948, filed March 23, 1992, the subject of previous Appeal No. 95-3046 decided on March 14, 1997. The examiner withdrew this rejection due to appellant's submission of a terminal disclaimer.

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is to be made under 35 U.S.C. § 103, the proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. See In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). Furthermore, as a starting point for a § 103 rejection, there must be a reference, a "something in existence," the design characteristics of which are basically the same as the claimed design:

Thus there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.

Rosen at 673 F.2d 391, 213 USPQ 350.

The examiner's position is based upon the view that elements 26 and 30 comprise the claimed shutter for an optical disc cartridge. Page 5 of the answer indicates that element 28, which is one side of two sides (26 and 28) of the overall shutter 22 in Shiba's various figures was not a part of the rejection. This view is well taken by the examiner inasmuch as column 3, lines 64 through 68 of Shiba indicates that the shutter assembly may be

considered optionally designed as one-sided. As such, we consider that it would have been obvious to the artisan as to which side to choose to include or eliminate. In light of this teaching, we disagree with appellant's characterization that Shiba is not a Rosen-type reference since the resulting design is a something in existence, the design characteristics of which are basically the same as the claimed design.

This conclusion, however, does not lead us to further conclude that the design claim on appeal would have been obvious to the artisan within 35 U.S.C. § 103. Shiba's showing of a single-sided shutter does indicate that the bottom portion of the remaining side of the shutter does gently rise in an angle, reorients parallel to the main portion of the shutter side, and finishes with the rounded ends (Figures 7 and 8) in the manner claimed.

Significant to us is that the appealed claim has a T-shaped crosspiece whereas the teachings and showings in Shiba indicate that a corresponding crosspiece member is essentially L-shaped. Compare figures 3, 5 and 7 of the disclosed/claimed design with figures 7 and 8 of Shiba. Shiba's figure 8 shows shutter slide

30 with a single horizontally extended region on it opposite the engagement hole 36. This extended region also has a vertical projection at its end farthestmost from the body of shutter slide 30, which projection is normal to the upper shutter blade 26 in Figure 8.

This extended region of the shutter slide 30/crosspiece in Shiba including its L-shaped nature leads us to conclude that the claimed T-shaped design of the corresponding crosspiece with its two extended regions beyond the width of the body of the shutter per se embodies a patentably distinct design. The longer portion of the crosspiece of the claimed design is also of a different, non-obvious configuration than the single extended portion of Shiba's crosspiece. What the examiner regards as minute details or slight variations in the connecting element or crosspiece (answer pages 2-3) lead us to conclude that the design claim on appeal presents a patentably distinct overall appearance over that shown in Shiba.

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In view of the foregoing, the decision of the examiner  
rejecting the design claim on appeal under 35 U.S.C. § 103 is  
reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN D. SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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